



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,107	08/27/2001	Brian L. Klosterman	ST/037 CONT 2.	4286

7590 11/30/2006

Alexander Shvarts
Fish & Neave
1251 Avenue of the Americas
New York, NY 10020-1105

EXAMINER

TRAN, HAI V

ART UNIT	PAPER NUMBER
----------	--------------

2623

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/940,107	Applicant(s) KLOSTERMAN ET AL.	
	Examiner Hai Tran	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/18/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 2,6 and 9-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,8 and 29-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 09/18/2006 have been fully considered but they are not persuasive.

Applicant argues (page 12), "...Applicant respectfully submit that disclosure cannot be found in Alexander for "inserting at the headend in said outgoing television signal on said first particular channel an instruction to any television system that receives said television signal to change channels to a second particular channel, wherein said instruction indicates a duration of time."

In response, the Examiner respectfully disagrees with Applicant because the "instruction includes a duration of time" reads on Alexander' message which includes commands that tune the television automatically to a particular advertising channel at the time during the telecast of the television program during which an advertisement is scheduled to occur, and tune the television back to the viewer's chosen television program at the conclusion of the advertisement (see Col. 32, lines 61-Col. 33, lines 1). In doing so, the instruction of "tuning back" clearly depends on the duration of time to display the corresponding advertisement until its conclusion because each advertisement has a time period pre-set by the advertiser for displaying it. In view of that, Alexander' s message encompasses the claimed limitation "instruction includes a duration of time". as such, the Examiner maintains the rejection.

Claim Objections

Claims 45 and 48 are objected to because of the following informalities: limitation "viewer's television set" should be changed -- viewer 's television system --.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 3-5, 7-8, and 29-52 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Alexander et al. (US 6177931).

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim 1, Alexander discloses a method for substituting advertising information to be displayed on the viewer's television system in the place of the information that would otherwise be displayed according to the channel to which the viewer has tuned the television system, the method comprising

monitoring at a head end an outgoing television signal for a first particular channel (Col. 34, lines 56-Col. 35, lines 26);

identifying a point in the outgoing television signal at which said signal begins carry advertising information (Col. 34, lines 56-Col. 35, lines 26);

inserting at the headend in said outgoing television signal on said first particular channel an instruction to any television system that receives said television signal to change channels to a second particular channels, wherein the instruction includes a duration of time (trigger/message; Col. 32, lines 27-Col. 33, lines 8; Notes: "instruction includes a duration of time" reads on Alexander' message which includes commands that tune the television automatically to a particular advertising channel at the time during the telecast of the television program during which an advertisement is scheduled to occur, and tune the television back to the viewer's chosen television program at the conclusion of the advertisement; see Col. 32, lines 61-Col. 33, lines 1. In doing so, the instruction of "tuning back" clearly depends on the duration of time to display the corresponding advertisement until its conclusion because each advertisement has a time period pre-set by the advertiser for displaying it. In view of that, Alexander' s message encompasses the claimed limitation "instruction includes a duration of time");

receiving the television signal at a viewer's television system on the 1st particular channel (Col. 26, lines 60-Col. 27, lines 2);

tuning the viewer's television system to the 2nd particular channel (Ad channel/window) for the duration of time (reads on conclusion of the advertisement; see Col. 32, lines 60-Col. 33, lines 8); and

tuning the viewer's television set to the 1st particular channel after the duration of time (reads on tuning the television back after the duration to display the advertisement; Col. 32, lines 60-Col. 33, lines 8) .

Claim 3, wherein the 2nd particular channel is an advertisement information (Col. 26, lines 64-Col. 27, line 2 and Col. 32, lines 61-67+).

Claim 4, further comprising displaying the alternative advertisement information on a pre-determined portion of the EPG (Col. 26, lines 64-Col. 27, lines 2).

Claim 5 , the system claim is analyzed with respect to method claim 1.

Claim 7, the system claim is analyzed with respect to method claim 3.

Claim 8, the system claim is analyzed with respect to method claim 4.

Claim 29, Alexander further discloses maintaining at the head end a database of channel (EPG) and advertising intercept information (inherent; Col. 15, lines 23-31; Col. 17, lines 38-Col. 20, lines 12).

Claim 30, the system claim is analyzed with respect to method claim 29.

Claim 31. (new) Alexander discloses a method for substituting alternative advertising information to be displayed on a viewer's television system in the place of information that would otherwise be displayed according to the channel to which the viewer has tuned the television system, the method comprising the steps of:

maintaining at a viewer's television system a database of channel (Col. 32, lines 7-21) and advertising intercept information (Col. 32, lines 46-60);

monitoring at the viewer's television system an incoming television signal for a first particular channel (Col. 32, lines 50-Col. 33, lines 43);

identifying a point in said incoming television signal at which said signal begins to carry advertising information, and determining whether said incoming television signal should be intercepted based on said channel and advertising intercept information; and in response to said determination, tuning said viewer's television system to said second particular channel (Col. 33, lines 44-65).

Claim 32, Alexander further discloses wherein said second particular channel is an advertisement channel providing advertisement information (Col. 33, lines 44-65).

Claim 33, Alexander further discloses determining whether a particular advertisement should be intercepted with a channel change command based on said database of channel (EPG) and advertising intercept information (viewer preference) (Col. 33, lines 15-43).

Claim 34, Alexander further discloses tuning said viewer's television set to said first particular channel after a particular duration of time (Col. 32, lines 61-Col. 33, lines 1).

Claim 35, Alexander further discloses wherein the viewer's local television system further comprises a database of television program guide information ((Col. 32, lines 7-21);

Claim 36, Alexander further discloses determining whether to block the information currently tuned by the viewer's television system based on said database of channel and advertising information (Col. 32, lines 61-Col. 33, lines 8);

Claim 37, Alexander further discloses wherein said database of television program guide information comprises pointers to entries in the database of channel and advertising intercept Information (Col. 34, lines 10-55).

Claim 38, the system claim is analyzed with respect to method claim 31;

Claim 39, the system claim is analyzed with respect to method claim 32;

Claim 40, the system claim is analyzed with respect to method claim 33;

Claim 41, the system claim is analyzed with respect to method claim 34;

Claim 42, the system claim is analyzed with respect to method claim 35;

Claim 43, the system claim is analyzed with respect to method claim 36;

Claim 44, the system claim is analyzed with respect to method claim 37;

Claim 45, Alexander discloses a method for substituting alternative advertising information to be displayed on a viewer's television system in the place of information that would otherwise be displayed according to the channel to which the viewer has tuned the television set, the television system, the method comprising the steps of:

maintaining at a head end a database of channel and advertising intercept information (Col. 29, lines 13-21);

monitoring at the head end an outgoing television signal for a first particular channel (Col. 34, lines 56-Col. 35, lines 26);

identifying the point in the outgoing television signal at which said signal begins carry advertising information (Col. 34, lines 56-Col. 35, lines 26) and determining whether the outgoing television signal should be intercepted based on the channel and advertising intercept information;

inserting at the headend in said outgoing television signal on said first particular channel in response to said determination an instruction to any television system that receives said television signal to change channels to a second particular channels (trigger/message; Col. 32, lines 27-Col. 33, lines 8; Notes: "instruction includes a duration of time" reads on Alexander' message which includes commands that tune the television automatically to a particular advertising channel at the time during the telecast of the television program during which an advertisement is scheduled to occur, and tune the television back to the viewer's chosen television program at the conclusion of the advertisement; see Col. 32, lines 61-Col. 33, lines

1. In doing so, the instruction of “tuning back” clearly depends on the duration of time to display the corresponding advertisement until its conclusion because each advertisement has a time period pre-set by the advertiser for displaying it. In view of that, Alexander’ s message encompasses the claimed limitation “instruction includes a duration of time”);

receiving the television signal at a viewer’s television system on the 1st particular channel (Col. 26, lines 60-Col. 27, lines 2);

recognizing the instruction at the viewer’s television system to change channels (see Col. 32, lines 61-Col. 33, lines 1) ; and

tuning the viewer’s television set (system) to the 2nd particular channel (Ad channel/window; Col. 32, lines 61-Col. 33, lines 1).

Claim 46, Alexander further discloses wherein the 2nd particular channel is an advertisement channel providing advertisement information (Col. 26, lines 64-Col. 27, line 2).

Claim 47, Alexander further discloses determining whether a particular advertisement should be intercepted with a channel change command based on the database of channel (EPG) and advertising intercept information (user preference) (Col. 33, lines 15-43).

Claim 48, Alexander further discloses tuning the viewer’ s television set (system) to the 1st particular channel after a particular duration of time (reads on

tuning the television back to the previous displayed channel after the time period/duration to display the advertisement; Col. 32, lines 60-Col. 33, lines 8) .

Claim 49, the system claim is analyzed with respect to claim 45;

Claim 50, the system claim is analyzed with respect to claim 46;

Claim 51, the system claim is analyzed with respect to claim 47;

Claim 52, the system claim is analyzed with respect to claim 48;

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

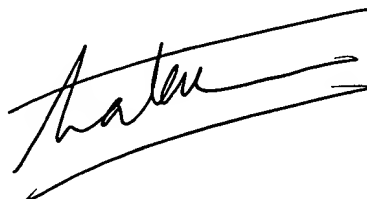
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT:ht
11/22/2006

A handwritten signature in black ink, appearing to read 'HAITRAN', is written over two horizontal lines.

**HAITRAN
PRIMARY EXAMINER**